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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/543,042

07/21/2005

Graham Robertson

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BARNES & THORNBURG LLP  
P.O. BOX 2786  
CHICAGO, IL 60690-2786

EXAMINER

GONZALEZ, MADELINE

ART UNIT

PAPER NUMBER

1797

NOTIFICATION DATE

DELIVERY MODE

11/21/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-ch@btlaw.com

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/543,042 | <b>Applicant(s)</b><br>ROBERTSON, GRAHAM |  |
|                              | <b>Examiner</b><br>MADELINE GONZALEZ | <b>Art Unit</b><br>1797                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

In reply to applicant's response dated August 20, 2008

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Ferrante (U.S. 2,425,235).

With respect to **claim 1**, Ferrante discloses a filter, as shown in Fig. 1, having:

- woven wire cloth 12 of orthogonal warp and weft wires, tensioned and bonded to a support structure 11 defining a rectangular opening across which the cloth 12 extends;
- wherein the orientation of the cloth 12 is chosen so that the warp wires 13 extend across the width (i.e. shorter dimension) of the rectangular opening and the weft wires 14 extend across the length (i.e. longer dimension) of the rectangular opening, as shown in Fig. 2.

With respect to **claim 2**, Ferrante discloses wherein the rectangular opening in the support structure 11 includes a plurality of similarly dimensioned, similarly orientated

Art Unit: 1797

and regularly arranged smaller rectangular openings or windows 15, formed by a lattice of struts criss-crossing the larger opening, and the cloth 18 is bonded to the lattice struts as well as the boundary of the larger opening, as shown in Fig. 4.

With respect to **claim 3**, Ferrante discloses wherein the warp wires 13 are also parallel to the width dimension (i.e. the shorter sides) of the smaller rectangular openings, as shown in Fig. 2.

With respect to **claim 4**, Ferrante discloses wherein the cloth 12 has a so-called rectangular mesh in that it has rectangular openings in the weave, formed by a greater number of warp wires per unit length than there are weft wires per unit length, as shown in Fig. 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-10 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrante (U.S. 2,425,235).

**Claim 5** include the limitation of the cloth having a square mesh. **Claims 5-10** include dimensional limitations, such relative size and cross-sectional area of the wires.

Ferrante **lacks** the specific shape and dimensional limitations.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a square mesh to the filter disclosed by Ferrante since the courts have held that a change in shape is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant (see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)). Furthermore, the specific dimensional limitations claimed by applicant, are considered to be nothing more than a choice of engineering skill, choice or design that a person having ordinary skill in the art would have found obvious during routine experimentation based among other things, on desired accuracy, since the courts have held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than a prior art device, the claimed device was not patentably distinct from the prior art device (see *In re Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (FED. Cir. 1984), cert. Denied, 469 U.S. 830, 225 USPQ 232 (1984)).

***Response to Arguments***

Applicant's arguments filed on August 20, 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that Ferrante does not make specific reference to any form of bonding: Ferrante teaches a screen material 12 secured to a frame 11, as shown in Fig. 1. The broadest definition of "bond" is to hold together (see Webster's New World Dictionary, 3<sup>rd</sup> College Ed.) and Ferrante teaches a screen material 12 and a frame 11 being held together.

In response to applicant's argument that there is no reference is Ferrante to tensioning the sheet of screening material across its frame: Ferrante teaches a window screen and it is well known that there has to be some tensioned when fitting the screen material into the opening of the frame. Furthermore, Ferrante suggests that there can be some tension applied to the screen material, and therefore, uses the application of a cementitious material at the intersections of the wires (see col. 1, lines 27-34). Applicant is reminded that claim 1 is a product claim, and the word "tensioned" is not a structural limitation and therefore had no patentable weight is a product claim.

In response to applicant's argument regarding the orientation of the wires: Ferrante teaches that the "wire mesh can be made by braiding the wires together or by cross-laying them in any desired manner" (see col. 1, lines 24-26). Therefore, the warp wires can extend across the width and the weft wires can extend across the length, as claimed by applicant.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MADELINE GONZALEZ whose telephone number is (571)272-5502. The examiner can normally be reached on M, T, Th, F- 8:30am-5:00pm, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1797

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Madeline Gonzalez  
Patent Examiner  
November 17, 2008

/Krishnan S Menon/  
Primary Examiner, Art Unit 1797